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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/824,811	04/15/2004	Yen-Fu Chen	AUS920031072US1	6690
35525	7590	03/17/2009		
IBM CORP (YA)				
C/O YEE & ASSOCIATES PC				
P.O. BOX 802333				
DALLAS, TX 75380				
EXAMINER				
BELANI, KISHIN G				
ART UNIT		PAPER NUMBER		
2443				
NOTIFICATION DATE		DELIVERY MODE		
03/17/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ptonotifs@yeciipaw.com

Office Action Summary

Application No.

10/824,811

Applicant(s)

CHEN ET AL.

Examiner

KISHIN G. BELANI

Art Unit

2443

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This action is in response to Applicant's amendment filed on 12/03/2008.

Independent Claim 36 has been amended. Claim 36 is now pending in the present application. The applicants' amendments to claims are shown in ***bold and italics***, and the examiner's response to the claim amendments is shown in **bold** in this office action. **This Action is made FINAL.**

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Briggs et al. (US Patent Publication # 7,080,139 B1)** in view of **Herf et al. (U.S. Patent Application Publication # 2005/0021624 A1)** and further in view of **Marston et al. (US Patent Application Publication # 2004/0260710 A1)** and further in view of **Bogard (U.S. Patent Publication # 6,757,365 B1)** and further in view of **St. John et al. (US Patent Application Publication # 2006/0004702 A1)** and further in view of **Solomon (US Patent Application Publication # 2005/0164154 A1)**.

Consider **claim 36**, Briggs et al. show and disclose a method for using topic tags in an Instant Messaging System (column 2, lines 26-41 which disclose an Instant Messaging System that collects a user's computer usage experience and shares that data among the user's buddies; Fig. 8D that shows a "Topic Sharing" tab and a list of topics 892 to select/deselect from by clicking in the checkboxes 891 or specifying the

topic tags 893 entered by the user; column 8, lines 42-45 disclose the same details), comprising:

identifying a topic (Fig. 8D, topics list 892, checkboxes 891 for identifying a topic, "+ Add Topic Area" 893 for a custom topic; column 8, lines 42-45 disclose the same details) by performing a first plurality of steps comprising:

displaying a topic tag for a chat using an instant messaging service that allows a **first** user to send and receive text messages in real time with a **second** user (Fig. 8D that shows a "Topic Sharing" tab and displays a list of topics 892 for a **first** user to select/deselect from, by clicking in the checkboxes 891 or specifying the topic tags 893 entered by the user; column 8, lines 42-45 disclose the same details; column 4, lines 32-40 that describe an instant messaging service that allows a user to send and receive text messages in real time with a **second** user in a chat session);

determining whether the **first** user wants to accept the topic tag (Fig. 8D, displayed topics list 892, checkboxes 891 for identifying a topic selected by the **first** user, "+ Add Topic Area" 893 for a custom topic; the Instant Messaging System capable of determining whether the user wants to accept the topic tag by checking the status of the checkboxes selected by the **first** user);

responsive to determining that the **first** user does not want to accept the topic tag, determining whether the **first** user wants to distinguish the topic tag (Fig. 8D, displayed topics list 892, checkboxes 891 for identifying a topic selected by the **first** user, "+ Add Topic Area" 893 for a custom topic; the Instant Messaging System, responsive to determining that the **first** user does not want to accept the topic tag, determining

whether the **first** user wants to distinguish the topic tag by identifying any data in the "+ Add Topic Area" 893 for a custom topic);

responsive to determining that the **first** user wants to distinguish the topic tag, entering a term for the topic tag by the user (Fig. 8D, "+ Add Topic Area" 893 for a custom topic that enables the **first** user to distinguish the topic tag and the Instant Messaging System to determine that the **first** user has distinguished the topic tag; Fig. 9 that displays the user selected/entered topic in the message text, thereby disclosing entering a term for the topic tag by the **first** user in the message text);

responsive to entering a term for the topic tag, determining whether the **second** user accepts the term for the topic tag (Fig. 8D which describes that each user will be able to turn the displayed topic areas on or off; column 8, lines 42-45 disclose the same details, thereby enabling the Instant Messaging System to determine whether the **second** user accepts the term for the topic tag); and

responsive to the **second** user not accepting the term for the topic tag, using a default topic tag as the topic tag (column 8, lines 42-45 which further disclose that both default and particular user or user group administration is supported);

inserting the topic tag into a text **of the chat** (Fig. 9, topic column 983 and message text column 984 that together show that the topic tag is inserted into the text **of the chat**; column 9, lines 15-37 further describe the details of the columns shown in Fig. 9);

responsive to the **first** user identifying a subtopic tag for the chat, inserting the subtopic tag into the text **of the chat** (Fig. 8D, items 892 and 893; column 8, lines 42-45 which further disclose that topic or subtopic names 892 can be used; Fig. 9, topic column 983

and message text column 984 that together show that the topic/subtopic tag is inserted into the text **of the chat**; column 9, lines 15-37 further describe the details of the columns shown in Fig. 9);

responsive to determining that a topic shift has occurred (disclosed by Herf et al. below), repeating the first plurality of steps (Fig. 9 that shows a plurality of topics, each as a single row of analogous details, indicating repeating the steps of the first topic described above, for other subsequent topics);

searching the repository (Fig. 3, Search entry window 371 and Search (Find) button 372 that are used to accept search criteria from the user and search the repository for the content of desired items; Fig. 9, messages tab 965 that provides access to a message repository; filters 971-973 are provided for a narrower focused search; column 6, lines 37-51 and column 8, lines 56-67 through column 9, lines 1-14 further disclose the same details) by performing a second plurality of steps comprising:

determining whether the search will be a full text search (Fig. 9, View activity window with a dropdown list of either "All Activity" or a select topic search and display; column 9, lines 8-9 that further disclose viewing of all or selected portions of a participant's activity by topic, thereby determining whether the search will be a full text search);

responsive to determining that the search will not be the full text search, determining whether the search will be a filtered search (Figs. 3 and 9, who filter 971, topic filter 972, and view filter 973, search term window 974, find button 975, and advanced find button 976 that together provide filtering and focused search capabilities; column 9, lines 4-14 disclose the same details, providing means for a filtered search);

responsive to determining that the search will be the filtered search, choosing a filter, wherein **a plurality of** types of filter comprise: a topic tag, a user name, and a date (Figs. 3 and 9, who filter 971, topic filter 972, and view filter 973, search term window 974, find button 975, and advanced find button 976 that together provide filtering and focused search capabilities; column 9, lines 4-14 disclose the same details, providing means for a filtered search; Fig. 11; column 10, lines 54-56 which further disclose filter to select a range of dates; Fig. 9, column 988 shows the results of filtering by date);

conducting the search (Fig. 10 that shows a display of hit list after the filtered search has been done; column 9, lines 58-67 through column 10, lines 1-6 disclose the details of conducting the search);

determining whether the search was satisfactory (column 9, lines 30-35 which further disclose that in some instances, a user may need to access more detailed information about an activity in order to understand the topic involved, thereby disclosing determining whether the search was satisfactory);

responsive to determining that the search was not satisfactory, entering feedback by the user (Fig. 3, comments button 363 that when selected, activates a window for entering comments and feedback; column 6, lines 11-13 disclose the same details; Fig. 9, thumbs up/thumbs down 986 column, thoughts 987 column; column 9, lines 18-19 also describe the same details); and

responsive to determining that the **first** user wants to view the full text of a found topic, displaying a segment of the transcript corresponding to the found topic (Figs. 9-10,

columns 983-988 that display a segment of the transcript corresponding to the found topic, with next and previous buttons for scrolling the remaining data; column 9, lines 15-67 describe the same details);

responsive to determining that another search is to be conducted, repeating the second plurality of steps (Fig. 10, column 10, lines 1-6 which further disclose that when the (new) desired filters are selected, the submit button 1055 signals for the screen to be refreshed with the new information, indicating repeating the plurality of steps disclosed above).

However, Briggs et al. do not specifically disclose determining whether a turn has occurred; responsive to determining that a turn has occurred, determining whether a topic shift has occurred; saving a transcript of the chat to a repository in an XML format **(although Briggs et al. do disclose saving the content in a repository 100 shown in Fig. 1)**; scanning topic tags from the transcript by performing a third plurality of steps comprising: comparing a scanned topic tag to an auto alert table; responsive to determining that there is a match between the scanned topic tag and the auto alert table, determining and executing an action that is associated with the scanned topic tag in the auto alert table; wherein the action comprises exporting the transcript to an e-mail; responsive to determining that there is another scanned topic tag, repeating the third plurality of steps; wherein a plurality of bases upon which a determination that a turn has occurred comprise: an amount of textual data entered; a time period; or a plurality of successive statements; **wherein a turn means a shift in a textual communication during the chat indicated by the plurality of successive**

statements; and wherein a topic shift means a change from a first topic or a first subtopic to a second topic or a second subtopic in the chat where the change is indicated by a selection of a new topic marker, a new subtopic marker, or a new topic input entry field and an attachment of the new topic marker or the new subtopic marker to a chat transcript or a chat transcript segment.

In the same field of endeavor, Herf et al. disclose determining whether a turn has occurred, and responsive to determining that a turn has occurred, determining whether a topic shift has occurred, ***wherein a turn means a shift in a textual communication during the chat indicated by the plurality of successive statements*** (paragraph 0026, lines 1-6 which disclose that a “snapshot” of the state of the system may be taken when each comment is made (to detect whether a turn has occurred), and if the snapshot has changed substantially since the previous line in the conversation (***i.e. after successive comments***), the change is indicated with a thumbnail representing the change (determining whether a topic shift has occurred); paragraphs 0023, 0027, 0031, 0034, and 0054 further disclose the same details; **paragraph 0026 further discloses that a change to another document would be a sufficient change to qualify for a turn; paragraph 0025 disclosing that the document (external media element) may be an image, a text file, a presentation, etc.).**

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to determine whether a turn has occurred, and responsive to determining whether a turn has occurred, determine whether a topic shift has occurred, wherein a turn means a shift in a textual communication during the chat

indicated by the plurality of successive statements, as taught by Herf et al., in the method of Briggs et al., so as to mark different topics of discussion in order to later identify and understand which topics were discussed during the session.

However, Briggs et al., as modified by Herf et al., do not specifically disclose saving a transcript of the chat to a repository in an XML format; scanning topic tags from the transcript by performing a third plurality of steps comprising: comparing a scanned topic tag to an auto alert table; responsive to determining that there is a match between the scanned topic tag and the auto alert table, determining and executing an action that is associated with the scanned topic tag in the auto alert table; wherein the action comprises exporting the transcript to an e-mail; responsive to determining that there is another scanned topic tag, repeating the third plurality of steps; wherein a plurality of bases upon which a determination that a turn has occurred comprise: an amount of textual data entered; a time period; or a plurality of successive statements; **and wherein a topic shift means a change from a first topic or a first subtopic to a second topic or a second subtopic in the chat where the change is indicated by a selection of a new topic marker, a new subtopic marker, or a new topic input entry field and an attachment of the new topic marker or the new subtopic marker to a chat transcript or a chat transcript segment.**

In the same field of endeavor, Marston et al. do disclose saving a transcript of the chat to a repository (Fig. 1, database module 114 that stores message contents 130; paragraph 0021, lines 1-5 disclose the same details).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to save a transcript of a chat to a repository, as taught by Marston et al., in the method of Briggs et al., as modified by Herf et al., so as to later display the selected contents of the message to the participating users.

However, Briggs et al., as modified by Herf et al. and Marston et al., do not specifically disclose that the transcript of the chat is saved in an XML format; scanning topic tags from the transcript by performing a third plurality of steps comprising: comparing a scanned topic tag to an auto alert table; responsive to determining that there is a match between the scanned topic tag and the auto alert table, determining and executing an action that is associated with the scanned topic tag in the auto alert table; wherein the action comprises exporting the transcript to an e-mail; responsive to determining that there is another scanned topic tag, repeating the third plurality of steps; wherein a plurality of bases upon which a determination that a turn has occurred comprise: an amount of textual data entered; a time period; or a plurality of successive statements; ***and wherein a topic shift means a change from a first topic or a first subtopic to a second topic or a second subtopic in the chat where the change is indicated by a selection of a new topic marker, a new subtopic marker, or a new topic input entry field and an attachment of the new topic marker or the new subtopic marker to a chat transcript or a chat transcript segment.***

In the same field of endeavor, Bogard disclose saving the chat content in an XML format (Fig. 3, Instant Messaging Server 308, Voice Portal 310; column 12, lines 15-18 that disclose using XML to import their buddy list and textual data from the IM Server

308 using XML files; column 6, lines 32-44 further disclose using VoiceXML (VXML) for mobile devices);

responsive to determining that there is another scanned topic tag (column 10, lines 19-38 which show an introductory conversation topic that turns to a registration topic when the customer responds with a “No” to a question from the system), repeating the third plurality of steps (corresponding to determining that the user is not a registered user by checking a table of registered users (comparing the user’s entered userid with the entries in the registration table), and after determining that the entered userid “User1” matches an entry in the registered users table, executing an action by informing the user to select a different userid and then sending a confirmation e-mail for registration of the user; these steps are further disclosed by St. John et al. below); wherein a plurality of bases upon which a determination that a turn has occurred comprise: an amount of textual data entered; a time period; or a plurality of successive statements (column 10, lines 19-38 which disclose that a plurality of bases upon which a determination that a turn has occurred comprise a plurality of successive statements about the registration process;

Note: column 10, lines 19-38 also disclose the claimed feature “wherein a turn means a shift in a textual communication during the chat indicated by the plurality of successive statements” disclosed by Herf et al. above).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to save the chat content in an XML format, and responsive to determining that there is another scanned topic tag, repeating the third

plurality of steps, wherein a plurality of bases upon which a determination that a turn has occurred comprise: an amount of textual data entered; a time period; or a plurality of successive statements as taught by Bogard, in the method of Briggs et al., as modified by Herf et al. and Marston et al., because XML is a popular web-based mark up language, specifically suited for segmented content processing, and to alert the user about the change in the content topic.

However, Briggs et al., as modified by Herf et al., Marston et al., and Bogard, do not specifically disclose scanning topic tags from the transcript by performing a third plurality of steps comprising: comparing a scanned topic tag to an auto alert table; responsive to determining that there is a match between the scanned topic tag and the auto alert table, determining and executing an action that is associated with the scanned topic tag in the auto alert table; wherein the action comprises exporting the transcript to an e-mail; ***and wherein a topic shift means a change from a first topic or a first subtopic to a second topic or a second subtopic in the chat where the change is indicated by a selection of a new topic marker, a new subtopic marker, or a new topic input entry field and an attachment of the new topic marker or the new subtopic marker to a chat transcript or a chat transcript segment.***

In the same field of endeavor, St. John et al. disclose scanning topic tags from the transcript (paragraph 0061 which discloses that information items and their associated gists are stored in the active database 14 (in Fig. 1), wherein each client 26 can query (scanning topic tags) the database to obtain information about the topics of interest to the client) by performing a third plurality of steps comprising:

comparing a scanned topic tag to an auto alert table (Figs. 1 and 6; paragraphs 0061-0063 that disclose a method of handling auto alerts by the document server 8; further disclosing that the auto-alert contains at least the item identifier of the involved information item and the category of the terms that triggers the auto-alert); responsive to determining that there is a match between the scanned topic tag and the auto alert table, determining and executing an action that is associated with the scanned topic tag in the auto alert table (further disclosing in paragraph 0063 that the client manager searches the client profiles (auto-alert tables) to identify each client to whom the identified item is to be sent); wherein the action comprises exporting the transcript to an e-mail (paragraph 0063 which states that in some cases, the auto-alert message may take the form of an e-mail containing the information item).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to scan topic tags from the transcript by performing a third plurality of steps comprising: comparing a scanned topic tag to an auto alert table; responsive to determining that there is a match between the scanned topic tag and the auto alert table, determining and executing an action that is associated with the scanned topic tag in the auto alert table; wherein the action comprises exporting the transcript to an e-mail, as taught by St. John et al., in the method of Briggs et al., as modified by Herf et al., Marston et al. and Bogard, in order to deliver the information for the selected topic to each user who requested the information.

However, Briggs et al., as modified by Herf et al., Marston et al., Bogard, and St. John et al., do not specifically disclose ***wherein a topic shift means a change from a first topic or a first subtopic to a second topic or a second subtopic in the chat where the change is indicated by a selection of a new topic marker, a new subtopic marker, or a new topic input entry field and an attachment of the new topic marker or the new subtopic marker to a chat transcript or a chat transcript segment.***

In the same field of endeavor, Solomon discloses the claimed method ***wherein a topic shift means a change from a first topic or a first subtopic to a second topic or a second subtopic in the chat where the change is indicated by a selection of a new topic marker, a new subtopic marker, or a new topic input entry field and an attachment of the new topic marker or the new subtopic marker to a chat transcript or a chat transcript segment*** (Fig. 27 that shows six phases A-F, wherein phases A-C are tagged as Topic 1 and phases D-F are tagged as Topic 2, thereby showing that a topic shift means a change from a first topic to a second topic in the chat where the change is indicated by a selection of a new topic marker; paragraph 0124 discloses the same details).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to determine a topic shift as a change from a first topic or a first subtopic to a second topic or a second subtopic in the chat where the change is indicated by a selection of a new topic marker, a new subtopic marker, or a new topic input entry field and an attachment of the new topic marker or the new subtopic marker

to a chat transcript or a chat transcript segment, as taught by Solomon, in the method of Briggs et al., as modified by Herf et al., Marston et al., Bogard and St. John et al., in order to tag the chat text with appropriate tags for subsequent search.

Response to Arguments

Applicant's arguments with respect to claim 36 have been considered but are moot in view of the new ground(s) (use of the Solomon reference in rejecting the amended feature of claim 36) of rejection.

However, the examiner would like to respond to the arguments presented by the applicants in order to provide justification for maintaining the rejection for claim 36.

Consider **claim 36**. In **section A** of the long argument, the applicants argue that Briggs et al. reference does not teach the use of topic tagging. The examiner respectfully disagrees with this argument. When a user selects the option to "+ Add Topic Area" 893 for a custom topic, the user has to specify an identifying tag for the custom topic, so that it can be appropriately recorded while saving the topic, and so that it may be retrieved as one of the topic to discuss in later IM sessions. The applicants further argue that the Briggs reference only teaches the selection of a topic folder to share with other buddies. However, the selection of a topic folder would not be possible unless the folder was appropriately tagged beforehand, so that it may be displayed as one of the topic to be displayed for selection later. The applicants further state that with their invention, the user can assign topic tags before and/or after a chat, select from a list of topics before and/or after a chat, or applicants' system can automatically assign

topic tags that can later be used to search topics. This statement is irrelevant, because it is not part of the claim.

In **section B** of the argument, the applicants argue that Briggs teaches topic sharing, but is silent as to topic tags. The examiner begs to differ. As responded above, the option of custom topic creation discloses tagging topics. As to the applicants' argument that Briggs et al. do not teach that topics can be searched, the examiner responds by stating that when a user makes a selection (in Fig. 8D that shows displayed topic tags) for a specific topic, it will be searched in the repository, before the content being displayed. The argument that the "applicants' invention allows topics to be searched by a large number of participants, including management" is irrelevant, because it is not part of the claim.

In **section C** of the argument, the applicants allege that Briggs does not teach accepting a topic tag once a chat has begun. Again, this teaching is not part of the claim.

In **section D**, the applicants argue that Briggs et al. do not teach distinguishing a topic tag. Distinguishing, as used in the claim context, implies differentiating or selecting a different topic, which the Briggs reference does indeed teach by allowing a user to replace the default topic list with a custom topic.

In **section E**, the applicants argue that the Briggs reference does not teach entering a term for the topic tag. Again, the examiner disagrees with this assertion. When using a custom topic option, the user has to provide a topic tag or subject.

In **section F**, the applicants allege that Briggs et al. teach that only the user/creator will be able to turn the displayed topic areas on or off for each user-buddy, not the user-buddy himself. A user in a broad sense may be different from the creator, and therefore, both the creator and a user-buddy will be able to turn the displayed topic areas on or off, not only the creator. Moreover, in IM sessions, the content text may be a collaborative effort, and each participant may be both a user and a creator.

In **section G**, no new argument is presented, so the previous response applies.

In **sections H and I**, the applicants argue that Briggs reference does not teach inserting topics tags into the chat's text. The examiner's response is that the insertion of a topic tag in an IM text is performed by software based on the selection or identification of a topic in an IM session by the IM participants. The topic filter 972 in Fig. 9 in the Briggs reference enables selection of one or more tagged topics. Such a selection therefore discloses that a topic tag was inserted in the chat's text when the text was saved in the previous session.

In **section J**, the applicants allege that the Herf reference does not teach topic tags or a search mechanism. However, these features are taught in the Briggs reference, the examiner has selected the Herf reference to disclose the "turn" feature for a topic, which it does disclose. As pointed in the claim 36 rejection, in paragraph 0025 of the Herf reference, the shared media include textual documents.

In **section K**, the applicants state that the Herf reference unlike applicants' invention, does not determine whether a topic shift has occurred, and if a shift has occurred, tagging chat with another topic, so that the chat can be searched through

topic tags. This amendment to claim 36 is disclosed in the Solomon reference, as described in the rejection of claim 36 above.

Section L repeats the arguments already presented, for which the examiner has already provided response.

In **section M**, the applicants allege that Bogard teaches importing buddy list and textual data, not saving such data in an XML format. The examiner selected the Marston reference to disclose saving of IM session data, and then combine it with Bogard reference, to further disclose use of XML format during retrieval of such data, thereby disclosing both features (saving and XML format) in the claim element.

In **section N**, the applicants allege that if Briggs et al. do not disclose saving a transcript of the chat to a repository in an XML format, it could not possibly disclose searching the repository. The examiner states that the Briggs reference does not disclose saving the data in an XML format, it surely discloses saving the data (Fig. 1, data repository 100). The additional references were used to show use of XML format. Therefore, Briggs reference will have capability to search the repository, where it saved the data.

Sections O and P present no clear argument and therefore examiner presents no response.

In **section Q**, the applicants argue that Briggs teaches topic subject, not topic tags. In a broad interpretation of the word tag, the examiner has considered both a tag and a subject as identifiers of topic content, and therefore considers them equivalent.

Section R presents no new argument. No response is therefore required.

In **section S**, the applicants allege that the Briggs reference teaches how a user can refine the search, not “determining whether the search was satisfactory. The examiner begs to differ. A user will refine a search only if the search results were not satisfactory. So, before a refined search is attempted, a determination has to have been made that the search was not quite satisfactory.

In **section T**, the applicants further argue that the Briggs reference also does not teach entering feedback by the user if a search was not satisfactory. The examiner has pointed out comment button 363 in Fig. 3, that when clicked, activates a comment window for the user to add his or her feedback; furthermore, Fig. 9 shows a visual thumbs up/thumbs down response to the search results.

In **section U**, the applicants provide no new argument, and in **section V**, fail to list which steps are not taught by Briggs.

In **section W**, the applicants argue that St. John reference uses keyword search which is a problem because keyword can occur within the context of many different topics. The examiner states that the word “gist” in the St. John reference is not a single keyword, but a short summary of the content that uniquely identifies the content (see paragraph 0056).

In **section X**, the applicants allege that the St. John reference searches the data base using key words to find topic of interest, so comparing a scanned topic tag to an auto alert table cannot be taught. In response, the examiner restates that the St. John reference does not rely on keyword search, but uses item identifiers as unique items

assigned to facilitate subsequent processing and indexing (see paragraph 0037). They are equivalent to meta tags in XML.

The argument presented in **sections Y and Z** is irrelevant to the claim text, since a client manager is not part of the claim content.

Section AA presents no new argument.

Finally, in **section BB**, the applicants allege that in the Bogard reference, there is no turn in the conversation listed, because the entire conversation deals with the topic of registration. The examiner respectfully disagrees with this allegation. The first conversation is an introductory conversation that turns to registration only after the user answers "No" to the initial question. If the response were a "Yes" answer, there would be no registration discussion.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any response to this Office Action should be **faxed to (571) 273-8300 or mailed to:**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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Hand-delivered responses should be brought to

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Randolph Building
401 Dulany Street
Alexandria, VA 22314

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Kishin G. Belani whose telephone number is (571) 270-1768. The Examiner can normally be reached on Monday-Friday from 6:00 am to 5:00 pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Tonia Dollinger can be reached on (571) 272-4170. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status

information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or 703-305-3028.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist/customer service whose telephone number is (571) 272-0800.

/K. G. B./
Examiner, Art Unit 2443

March 3, 2009

/George C Neurauter, Jr./
Primary Examiner, Art Unit 2443